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Docket No. G-067US03REG
Serial No. 09/603,665Remarks

Claims 79-132 are pending in the subject application. Applicants gratefully acknowledge the Examiner's withdrawal of the finality of the rejections in the Office Action dated September 22, 2004. By this Amendment, Applicants have amended claims 80-86, 95-99, and 112-126. Support for the amendments can be found throughout the subject specification and in the claims as originally filed. Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 79-132 are currently before the Examiner. Favorable consideration of the pending claims is respectfully requested.

Claims 79-132 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Office Action sets forth an argument that the specification fails to provide adequate written description of polypeptides comprising at least 10 contiguous amino acids of SEQ ID NO: 5 as only one species of hundreds of millions of potential species is exemplified in the application. The Office Action also argues that the claims reciting "variants" are rejected on these grounds as the specification fails to provide any information as to the biological activity or structure of these fragments or variants. Applicants respectfully assert that there is adequate written description in the subject specification to convey to the ordinarily skilled artisan that they had possession of the claimed invention.

As an initial matter, Applicants note that the rejection has been improperly applied to claims that recite "a polypeptide comprising SEQ ID NO: 5" (e.g., claims 128-132). Each of these claims recite a polypeptide that comprises SEQ ID NO: 5. As the as-filed specification specifically sets forth the chemical structure of SEQ ID NO: 5, it is respectfully submitted that the rejection has been improperly set forth against these claims and withdrawal of the rejection as set forth against these claims is respectfully requested.

In regard to the rejection as is applied to claims directed to a polypeptide comprising fragments of at least 6 or 8 or 10 contiguous amino acids of SEQ ID NO: 5, Applicants note that the term "comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim

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(see *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997)). Applicants have provided the sequence of amino acids that are identified in SEQ ID NO: 5 and have, thus, established possession of the claimed invention. While it is recognized that the claims cover molecules that include the recited sequences joined with additional sequences, the open nature of the transitional phrase "comprising" does not mean that applicants were not in possession of such polypeptides. For example, the specification teaches the fusion of the claimed polypeptides, and fragments thereof, to various elements to form "chimeric polypeptides" (see page 49, lines 10-27; page 52, lines 21-37; and page 112, lines 15-19). The use of the transitional term "comprising" does not allow for internal alterations (e.g., insertions or deletions) of the sequence set forth in SEQ ID NO: 5, but instead only allows for the addition of elements at either end of the sequence. The fact that the claimed polypeptide fragment can have additional elements attached to either, or both, ends does not in any fashion alter the fact that the as-filed specification provides adequate written description of polypeptide fragments comprising a recited span of contiguous amino acids of SEQ ID NO: 5.

Turning to the issue as relates to "variants" of the claimed polypeptide, Applicants note that the specification indicates that a number of homologs of the claims BAP28 polypeptide are known (see page 48, lines 21-32) and that an alignment of the sequences are provided at Figure 3 of the as-filed specification. This alignment would give one skilled in the art guidance as to those amino acids that could be substituted or deleted without affecting the overall nature of the claimed polypeptide. The specification also teaches various examples of "variant proteins and fragments thereof" at the paragraph bridging pages 49-50 and at page 15, lines 15-37. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested.

Claims 80, 82, 83, 86, 96, 97, 109-111, 121, 123-125, 127, 129, 130, and 132 are rejected under 35 U.S.C. § 102(b) as anticipated by Bowcock *et al.* (WO 98/12327, 1998). In addition, claims 80, 81, 86, 95, 121, and 122 are rejected under 35 U.S.C. § 102(b) as anticipated by Homburger *et al.* (U.S. Patent No. 6,703,491). Applicants respectfully assert that the cited references do not anticipate the claimed invention. For example, Bowcock *et al.* fail to teach sequences that are identical to the spans recited within the claims; that is, none of the sequences identified in the Office Action are identical to the contiguous spans of SEQ ID NO: 5 that include the positions recited in the

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claims (e.g., contiguous spans (spans of consecutive amino acids) that include position 1854, 1967, or 2017 of SEQ ID NO: 5). Turning to the rejection of the claims as anticipated by Homburger *et al.*, Applicants respectfully submit that the cited reference fails to teach a contiguous span of at least 8 amino acids that are identical to the sequence that includes position 1694 of SEQ ID NO: 5. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(b) is respectfully requested.

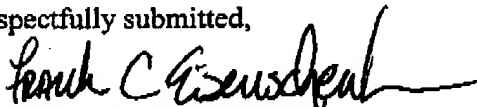
It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants' agreement with or acquiescence in the Examiner's position. Applicants expressly reserve the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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